

PRE-APPEAL BRIEF REQUEST FOR REVIEW

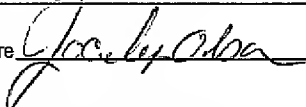
Docket Number (Optional)

36032/093

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on February 16, 2009

Signature



Typed or printed name Jocelyn Olson

Application Number

09/813,075

Filed

March 20, 2001

First Named Inventor

Edward F. Chamberlain

Art Unit

3644

Examiner

Tien Quang Dinh

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/Michael Pruden/

Signature

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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February 16, 2009

Date

Registration number if acting under 37 CFR 1.34

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".

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*Total of 1 forms are submitted.

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Practitioner's Docket No. 36032/093

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Edward F. Chamberlain et al.

Application No.: 09/813,075

Group No.: 3644

Filed: 03/20/2001

Examiner: Tien Quang Dinh

For: PORTABLE BALLOON LAUNCHER

Mailstop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following remarks accompany a notice of appeal and a pre-appeal brief request for review. Please enter the remarks as set forth below.

REMARKS

I. General:

The office action dated November 14, 2008 was made final because according to the Examiner, Applicant's amendments necessitated the new grounds of rejection. For at least the reasons that follow, Applicants respectfully submit that the finality of the office action was improper.

Claims 9, 10, 12, 13, 25, 26, 27, 28, 30, and 35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,195,835 to Eyre et al. (hereinafter referred to as "Eyre") in view of U.S. Patent No. 4,034,518 to Trecker (hereinafter referred to as "Trecker") and possibly the admitted prior art on page 4 of the disclosure. For at least the reasons that follow, Applicants respectfully request reconsideration and withdrawal.

Claims 22-24, 32, 33, and 34 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Eyre, Trecker and further in view of U.S. Patent No. 6286462 to Burns (hereinafter referred to as "Burns"). For at least the reasons that follow, Applicants respectfully request reconsideration and withdrawal.

Claims 11, 21, 29, and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Eyre, Trecker and further in view of U.S. Patent No. 4,034,518 to Bernier (hereinafter referred to as "Bernier"). For at least the reasons that follow, Applicants respectfully request reconsideration and withdrawal.

II. The finality of the previous office action is improper and should be withdrawn.

For the first time during prosecution, the Examiner cited the Trecker reference when rejecting the claims in the most recent final office action. While the Examiner contends that Applicants' amendment from 9/10/07 and 1/14/08 necessitated the new grounds of rejection, i.e. the rejections using the Trecker reference, Applicants point out that claim 9 and many of the other claims as well have never been amended. Accordingly, claim 9 and many of the other claims are in original form. It is simply not proper for the Examiner to cite the Trecker reference and use this reference to reject these claims for the first time, while simultaneously making the office action final.

The M.P.E.P. is clear in this regard. See M.P.E.P. § 706.07(a), which provides that "[s]econd or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is not necessitated by applicants' amendment of the claims." In the present instance, the Examiner has in fact introduced a new ground of rejection, i.e. the 35 U.S.C. § 103(a) rejection of claim 9 (and many other claims). In the present instance, this rejection was also not necessitated by Applicants' amendment to claim 9 (and many other

claims) because Applicants have never amended this claim. Accordingly, the use of the Tracker reference, by the Examiner, for the first time in the final action, is contrary to the rules set forth in the M.P.E.P. Applicants respectfully request that the finality of the office action be withdrawn and that the prosecution be reopened.

III. Trecker is non-analogous art; and, therefore, Trecker cannot be relied upon under 35 U.S.C. § 103.

To rely on a reference under 35 U.S.C. § 103 a cited reference must be analogous prior art. See M.P.E.P. § 2141.01(a), I. The M.P.E.P. provides that a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole. See M.P.E.P. § 2141.01(a), I. In the present situation, the invention relates to balloon launched instrumentation and to a system for simplifying the deployment of the balloon that carries the instrumentation aloft. See US 20030027652, ¶ 001. In contrast, Trecker relates to an "improved portable camping cot and table of the present invention comprise two box sections of equal size hinged to each other so that they can fold into a closed box like structure that forms a carrying case but said box sections can swing away from each other to form a flat surface on which a person can sleep or which can be used as a table." Trecker, Col. 1, ll. 44-50. An improved portable camping cot and table would not logically commend itself to an inventor's attention considering the nature of the invention relates to a system for balloon launching instruments.

The M.P.E.P also provides that "[w]hile Patent Office classification of references and cross-references in the official search notes of the class definitions are some evidence of "nonanalogy" or "analogy" respectively, the court has found "the similarities and differences in structure and function of the inventions carry far greater weight." M.P.E.P. § 2141.01(a), II. Again, his present invention relates to system for balloon launching instrumentation. The camping cot and table of Trecker is completely unrelated. Further, the present application and Trecker are not in the same U.S. Patent Office class.

It is also, undeniable that there are substantial differences between the function of launching instrumentation with a balloon and the function of a camping cot and table. The present situation is unlike any of the examples set forth in M.P.E.P. § 2141.01(a), where the cited reference and the art was found to be analogous because the art and the invention were found to have similar functions and structures.

For example, see, in In re Ellis, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) where the court determined that:

“the structural similarities and functional overlap between the structural gratings shown by one reference and the shoe scrapers of the type shown by another reference were readily apparent, and therefore the arts to which the reference patents belonged were reasonably pertinent to the art with which appellant’s invention dealt (pedestrian floor gratings).” M.P.E.P. § 2141 (a), II.

Accordingly, in this example, both the structure and function were related.

Also, see, In re Bigio, 381 F.3d 1320, 1325-26, 72 USPQ2d 1209, 1211-12 (Fed. Cir. 2004), where:

“The patent application claimed a “hair brush” having a specific bristle configuration. The Board affirmed the examiner’s rejection of the claims as being obvious in view of prior art patents disclosing toothbrushes. 381 F.3d at 1323, 72 USPQ2d at 1210. The applicant disputed that the patent references constituted analogous art. On appeal, the court upheld the Board’s interpretation of the claim term “hair brush” to encompass any brush that may be used for any bodily hair, including facial hair. 381 F.3d at 1323-24, 72 USPQ2d at 1211. With this claim interpretation, the court applied the “field of endeavor test” for analogous art and determined that the references were within the field of applicant’s endeavor and hence was analogous art because toothbrushes are structurally similar to small brushes for hair, and a toothbrush could be used to brush facial hair. 381 F.3d at 1326, 72 USPQ2d at 1212.” M.P.E.P. § 2141.01(a), IV.

Again, in this example, both the structure and function were related.

Also see In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986), where:

Applicant’s claims related to double-acting high pressure gas transmission line compressors in which the valves could be removed easily for replacement. The Board relied upon references which taught either a double-acting piston pump or a double-acting piston compressor. The court agreed that since the cited pumps and compressors have essentially the same function and structure, the field of endeavor includes both types of double-action piston devices for moving fluids.” M.P.E.P. § 2141.01(a), IV

Once again, in this example, both the structure and function were related.

Unlike the above examples, the function of the claims and the function of the camping cot and table device in Trecker are completely different. Accordingly, for at least the reasons above, Applicants submit that the present situation falls squarely within the non-analogous art situation set forth in M.P.E.P. § 2141.01(a). Since every rejection contained in the final office action relies on Trecker to some extent, each of the rejections is therefore improper and they should all be withdrawn.

IV. Neither Eyre, Trecker, Burns, nor Bernier, whether alone or in combination, each or suggest all the elements of claims 9-13 and 21-35.

Claim 9 recites the step of “opening a cover on a case and extending at least one panel from the case to provide a launch platform on which an uninflated balloon can be placed”. According to the Examiner, Trecker teaches this step. However, Trecker relates to a “portable

camping cot and table”. Trecker does not teach or suggest that the “portable camping cot and table” includes at least one panel that is extended to provide “a launch platform on which an uninflated balloon can be placed”, as the Examiner contends. Furthermore, one of ordinary skill in the art would not be motivated to use the “portable camping cot and table” of Trecker to provide a launch platform for a balloon. Therefore, for at least this reason, claim 9 and claims 10-13 and 21-26, which depend from claim 9, are allowable over Trecker even when combined with Eyre, Burns, and/or Bernier.

Regarding claims 12 and claim 27, according to the Examiner, Eyre “teaches that the canopy 13 is made out of light weight fabric” and one skilled in the art would have used Lycra as the material in the launch bag of Eyre as a mere substitution of parts. Applicants respectfully disagree. As the present application teaches, use of an elastic material cradles the balloon more securely as it is inflated. Chamberlain, Pg. 4, ll. 17-19. In particular, as figures 5 and 6 of the present application shows, use of an elastic material may allow the launch bag to cradle the balloon more securely during various stages of inflation.

Despite elastic materials being known at the time of the invention of Eyre, rather than including an elastic material in the canopy 13, the device of Eyre uses straps 61 that are let out as the balloon is inflated. Eyre, Col. 3, ll. 22-29. In this manner the straps 61 can be adjusted so that the canopy 13 cradles the balloon as it is inflated. Plainly, the device of Eyre takes a completely different approach than the present invention; and Applicants respectfully point out that given that the device of Eyre already includes straps it would not be obvious to include an elastic material, which were known at the time of Eyre, in the canopy 13 of Eyre. Therefore, for at least this reason, claims 12 and 27 and claims 28-35, which depend from claim 27, are allowable over the cited references

Furthermore, with respect to claim 12 and 27, although the Examiner contends that cotton is elastic, Applicants point out that Eyre does not teach that the canopy 13 is made from cotton. Accordingly, Applicants submit that the Examiner’s opinion on the elasticity of cotton is not germane to the issue of patentability. With respect to the Examiners comment about the criticality of this feature, Applicants are under no obligation to cite criticality of such a feature. The M.P.E.P. plainly provides that “all words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. Further, as already pointed out, use of an elastic material allows the launch bag to cradle the balloon as it is inflated. In contrast, Eyre uses straps that must be let out.

Claim 25 recites the step of “extending another panel from the case to provide the launch platform on which the uninflated balloon can be placed” and claim 35 recites “wherein the launch

site includes a launch platform that is provided, at least in part, by extending a first and a second panel from an open case”. According to the Examiner, Trecker teaches this step. However, as pointed out above with respect to claim 9, Trecker relates to a “camping cot and table”. Trecker plainly does not teach or suggest that the device is provided with panels that provide a launch platform on which an uninflated balloon can be placed, as the Examiner contends. Therefore, for at least this reason, claims 25 and 35 are allowable over the cited references.

Regarding claim 26, there simply is no requirement that Applicants “provide criticality” for the element “at least one of the panels extends beyond the end of the balloon”, as the Examiner requires. The M.P.E.P. plainly provides that “all words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. Furthermore, with respect to the Examiner’s contention that Applicants are trying to claim an apparatus and not a step, again, the M.P.E.P. plainly provides that “all words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. Moreover, there is nothing incorrect with claiming a method of using a particular structural arrangement. In view of the foregoing, Applicants submit that claim 26 is allowable over the cited art.

Claim 23 recites “at least one fitting that allows the case to be secured to a solid structure and claim 33 recites “at least one fitting that enables the case to be secured to a solid structure”. According to the Examiner Burns teaches a “fitting 34” that allows the case to be secured to a solid structure. Applicants respectfully point out that Burns teaches that the ring 34 is used for engaging hooks 32 so that a strap 30 may be used to carry or pull the pet carrier 20. Burns simply does not teach or suggest that the ring 34 allows the case to be secured to a solid structure.

Furthermore, while the Examiner contends that it would be obvious to take these structures from Burns and use them for the intended purpose of securing the system, neither of the cited references teach this purpose nor teach the desirability of this purpose. Therefore, for at least this reason, Applicants submit that claims 23 and 33 are allowable over the cited art.

IV. Conclusion:

Applicants submit that the subject matter of the present application is novel, nonobvious, and useful. Accordingly, Applicants respectfully request that the rejections and objections be withdrawn and that the present application issue as early as possible.

Dated: February 13, 2009

/Michael Pruden/
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